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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,747	10/23/2000	Christoph Kessler	4817/OR	5088

22829 7590 12/31/2002

ROCHE MOLECULAR SYSTEMS INC  
PATENT LAW DEPARTMENT  
1145 ATLANTIC AVENUE  
ALAMEDA, CA 94501

EXAMINER
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SAKELARIS, SALLY A

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 12/31/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/530,747

Applicant(s)

KESSLER ET AL.

Examiner

Sally A Sakelaris

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Response to Arguments***

1. This action is in response to Paper No. 16, filed October 16, 2002. Applicants arguments presented in the response of Paper No. 12 have been fully considered and are persuasive to overcome all grounds of previous rejection. All rejections not reiterated herein are hereby withdrawn. This action is non-final.

***Response to Amendment***

2. Applicants' amendments to claim 1 is acknowledged and entered. Accordingly, claims 1-9 are currently pending and under examination.

***THE FOLLOWING ARE NEW GROUNDS OF REJECTION:***

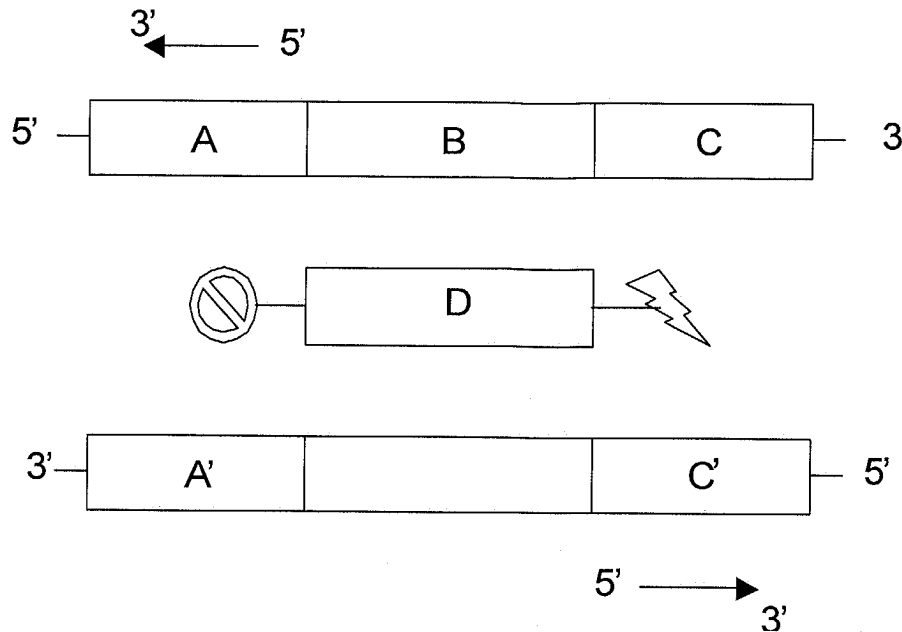
***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. Please see the figure below for clarification of the following first rejection.



A. (Continued)

Claims 1-9 are indefinite over the recitation of “one of which[primer] can bind to a first binding sequence A.” This instruction will result in the 3’ primer extension in the direction of A’s 5’ end. Likewise, Claim 1 is further indefinite over the recitation of “the other[primer] can bind to a second binding sequence C’ which is essentially complementary to a sequence C which is located in the 3’ direction from A.” As can be seen above, if the second primer binds to C’ and the first primer binds to A, an overlapping product will not exist. Applicant should amend the claim to clarify the resulting amplification product.

B. Claims 1-9 are indefinite over the recitation of “aid of.” It is not clear how the two primers are “aiding” this process being claimed. Applicant could amend this phrase by deleting “with the aid of” and adding “by amplifying said section of nucleic acid with.” Alternatively, applicant may amend how they see fit in order to clarify this claim.

C. Claims 1-9 are indefinite over the recitation of "can bind"(3<sup>rd</sup> line), "can bind"(4<sup>th</sup> line), and "can bind"(7<sup>th</sup> line) as it is unclear what implication "can" entails. Applicant could amend the aforementioned phrasings by deleting the "can bind"(Lines 3,4,and 7) and adding: "binds"(3<sup>rd</sup> line), "which binds"(4<sup>th</sup> line), and "binds"(7<sup>th</sup> line) respectively. Alternatively, applicant may amend the claim how they see fit in order to clarify.

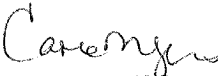
Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantae Dessau whose telephone number is (703)605-1237.

12/30/2002

  
Sally Sakelaris

  
CARLA J. MYERS  
PRIMARY EXAMINER